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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------------|------------------|
| 09/898,319 | 07/02/2001 | G. Scott Smith | 020699-000310US | 4767 |
| 37490 | 7590 | 11/15/2005 | | |
| CARPENTER & KULAS, LLP 1900 EMBARCADERO ROAD SUITE 109 PALO ALTO, CA 94303 | | | EXAMINER GELAGAY, SHEWAYE | |
| | | | ART UNIT 2137 | PAPER NUMBER |
| DATE MAILED: 11/15/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|------------------------------|--|
| Office Action Summary | Application No. 09/898,319 | Applicant(s) SMITH ET AL. | |
| | Examiner Shewaye Gelagay | Art Unit 2137 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to Applicant's Request for Continued Examination filed on September 12, 2005. Claims 1, 10 and 15 have been amended, claims 8-15 are added. Claims 1-6 and 8-16 are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recite "a first negotiated transmission key for decrypting the encrypted content", and then recites a further limitation, "a negotiated

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transmission key", however, the "negotiated transmission key" is not disclosed in the specification.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 3 recites the limitation "the single storage media" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-6, 10-13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki United States Letters Patent Number 6,807,365 in view of Nishimura et al. (hereinafter Nishimura) United States Letters Patent Number 6,834,111.

As per claims 1 and 10:

Aoki teaches a communication system having a storage system for receiving encrypted content, the storage system including storage media for storing content, a method for storing the encrypted content on the storage media, the method and apparatus comprising:

receiving the encrypted content; (Abstract; Col. 2, lines 14-34; Col. 3, lines 34-65; Col. 4, line 3)

receiving a first negotiated key for decrypting the encrypted content; (Col. 3, line 34-65; Col. 4, lines 3-4)

encrypting the first negotiated key to form a second key; (Col. 4, lines 4-6; Col. 14, lines 1-3)

combining the encrypted content with the second key to form a combined encrypted content; (Col. 14, lines 3-6)

storing the combined encrypted content on the storage media; (Figure 11; Col. 13, line 66-Col. 14, line 6)

in response to a request for the stored encrypted content, decrypting the encrypted content to obtain clear text content; (Abstract; Col. 14, lines 7-18)

encrypting the clear text content with a negotiated transmission key; (Col. 4, lines 4-6; Col. 14, lines 1-3) and

transmitting the encrypted content; (Abstract; Col. 2, lines 14-34; Col. 3, lines 34-65; Col. 4, line 3; Col. 11, lines 3-20)

Aoki does not explicitly disclose receiving the encrypted content via the IEEE 1394 bus. Nishimura in analogous art, however, discloses receiving the encrypted

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content via the IEEE 1394 bus. (Col. 11, lines 53-58; Col. 20, lines 17-20; Col. 21, lines 2-4) Therefore, it would have been obvious to one ordinary skill in the art to modify the method disclosed by Aoki as suggested by Nishimura (Col. 20, line 55-56) in order transfer data such as picture, voice, etc. requiring real-time guarantee.

As per claim 2:

The combination of Aoki and Nishimura teach all the subject matter as discussed above. In addition, Aoki further discloses wherein said decrypting step further comprises:

retrieving the combined encrypted content from the storage media; (Figure 11; Col. 13, line 66-Col. 14, line 6)

decrypting the second key to obtain the first negotiated key; (Abstract; Col. 14, lines 7-18) and

decrypting the encrypted content with the first key to recover clear text content. (Abstract; Col. 14, lines 7-18)

As per claims 3 and 13:

The combination of Aoki and Nishimura teach all the subject matter as discussed above. In addition, Aoki further discloses a method and an apparatus comprising:

further encrypting the second key prior to storage on the single media. (Col. 4, lines 4-6; Col. 14, lines 1-3)

As per claims 4 and 11:

The combination of Aoki and Nishimura teach all the subject matter as discussed above. In addition, Aoki further discloses a method and an apparatus wherein the combined encrypted content includes a stream. (Col. 8, lines 30-41)

As per claim 6:

The combination of Aoki and Nishimura teach all the subject matter as discussed above. In addition, Aoki further discloses a method comprising:

receiving the second key and the encrypted data; (Abstract; Col. 2, lines 14-34; Col. 3, lines 34-65; Col. 4, line 3)

decrypting the second key to form the first key; (Abstract; Col. 14, lines 7-18) and
decrypting the encrypted data with the first key to form clear text. (Abstract; Col. 14, lines 7-18)

As per claims 5 and 12:

The combination of Aoki and Nishimura teach all the subject matter as discussed above. In addition, Nishimura further discloses a method and an apparatus a header with the combined encrypted content stream. (Col. 20, lines 17-65)

As per claim 16:

The combination of Aoki and Nishimura teach all the subject matter as discussed above. In addition, Aoki further discloses comprising:

a decryption module, coupled to said combiner and said storage media device, adapted to receive key information from said combiner and encrypted content and key from said storage media device and to generate clear text content; (Figure 7; Abstract; Col. 14, lines 7-18) and

an encryption module, coupled to said decryption module, for encrypting said clear text content with a second negotiated key. (Figure 7; Abstract; Col. 14, lines 7-18)

9. Claims 8-9 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki United States Letters Patent Number 6,807,365 in view of Nishimura et al. (hereinafter Nishimura) United States Letters Patent Number 6,834,111 and further in view of Just et al. (hereinafter Just) United States Letters Patent Number 6,567,914.

As per claims 8 and 14:

The combination of Aoki and Nishimura teach all the subject matter as discussed above. Neither of the references explicitly disclose a method wherein the further encrypting uses a different algorithm than that used that used in encrypting the first key.

Just in analogous art, however, discloses a method and apparatus wherein the further encrypting uses a different algorithm than that used that used in encrypting the first key. (Col. 8; lines 9-14)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the method and apparatus disclosed by Aoki and Nishimura to include wherein the further encrypting uses a different algorithm than that used that used in encrypting the first key. This modification would have been obvious because a person having ordinary skill in the art would have been motivated by the suggestions, provided by Just (Col. 8; lines 15-16) in order to facilitate a higher level of security for the encrypted message.

As per claims 9 and 15:

The combination of Aoki, Nishimura and Just teach all the subject matter as discussed above. In addition, Just further discloses a method and apparatus wherein an algorithm includes one or more of DES, XOR, M2, M6+, IDEA. (Col. 7, lines 13-18)


10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO Form 892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shewaye Gelagay whose telephone number is 571-272-4219. The examiner can normally be reached on 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shewaye Gelagay
11/04/05


MATTHEW SMITHERS
PRIMARY EXAMINER
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